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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,316	08/03/2006	Hikaru Miura	Q96216	5761
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,316

Applicant(s)

MIURA ET AL.

Examiner

Min Shin

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 8/3/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the initial filing on 8/3/2006. Claims 1-18 are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 5-12 and 15-18 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

a. Claims 5-8 refer to "computer program". The structural limitations are disclosed in the specification as computer code per-se and are not statutory

b. Claims 9-12 and 15-16 are further rejected under 35 U.S.C. 101 because the method claims are directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of

the machine or transformation must not merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, __F.3d__, 2008 WL4757.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3-4, 7-8 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 3, 7 and 11, the claim recites, among other, *selected pieces of information m and number of display n*. The calculation and/or the algorithm recites in the claim can result in indefinite outcome possibilities.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Meisel et al (US 2003/0033292)

Claims 1, 5, 9, 13, 15:

Meisel discloses information providing system for providing information responding to a retrieval request from a terminal, characterized in comprising:

a database having information, which an information provider provides, and a bid amount of money of said information stored correspondingly (paragraph 0024);

a displaying order deciding means for selecting corresponding pieces of information from said database responding to the retrieval request of information to decide a displaying order of said information based upon the bid amount of money that corresponds to each of these pieces of information; and

a means for transmitting information to the terminal so that information is displayed in said decided displaying order (Abstract and paragraphs 0019 and 0024)

Claim 2, 6, 10, 14, 16:

Meisel discloses the system of claim 1 and further discloses said displaying order deciding means is configured so as to decide the displaying order of information based upon a probability that is calculated from a ratio of the bid amount of money of each selected information over a sum of bid amounts of money of selected pieces of information (paragraph 0025)

Claims 3, 7, 11, 17 and 18:

Meisel discloses the system of claim 2 and further discloses characterized in that: said displaying order deciding means comprises:

a sum-of-bid-amount-of-money calculating means for acquiring the bid amount of money that correspond to information to calculate a sum of these bid amounts of money (paragraph 0024);

a ratio calculating means for calculating a ratio of the bid amount of money of information over said sum of bid amounts of money information by information (paragraph 0024); and

a displaying order deciding means for deciding one piece of information, which is displayed, from pieces of information based upon a probability proportional to magnitude of said calculated ratio of each information; and

said displaying order deciding means is configured so that:

the display is ranked based on the weighted average of the bid amount (paragraph 0089 and 0090).

NOTE: The recited claim language starting from "in case where the number of... " contains an algorithm or a formula. However, it is not clear. The examiner is interpreting the formula to be a method of ranking the ads based on the bid amount (e.g. bid amount of \$10 gets a bid selection probability based on that \$10 dollars). Furthermore, a formula and/or algorithm are deemed unpatentable unless incorporated

into another statutory class, such as a machine. The recited claim fails to do so. The applicant is encouraged to edit the claims to either more explicitly define the structures or the steps.

Claim 4, 8, 12:

Meisel discloses the method of claim 3 and further discloses

means for recording the number of times of display of each information in the terminal;

a means for recording the click number of each information displayed in the terminal; and

a means for calculating a ratio of the click number to said number of times of display for each selected information; and said displaying order deciding means decides the displaying order of information based upon a probability that is calculated from a ratio of the bid amount of money of information over said sum of bid amounts of money and a ratio of the click number to said number of times of display (paragraph 0089 and 0090).

NOTE: The claim limitation 1-8 uses the phrase "means for" or "step for", but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" or "step for" is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant **does not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or "step for").

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner notes that the following references included in the Applicant's information disclosure statements are also very pertinent to the invention and include many, if not all, of the claimed invention

- Boubek (US 2004/0068436)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Shin whose telephone number is (571) 270-3463. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Myhre can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS
5/25/2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688